

Claims 1-18 stand rejected under 35 USC 103(a) as being unpatentable over Ho et al, U.S. Patent No. 5,805,298, alone or in view of Fabbio et al., U.S. Patent No. 5,870,089. It is contended in the Office Action that Ho teaches all the claimed elements of the applicants' invention with the exception of specifically sending a message via both facsimile and email. The Examiner further contended, however, that it would have been obvious to those skilled in the art to send the message via both facsimile and e-mail, thereby making the rejected claims obvious. The Examiner stated,

"While Ho did not specifically send the message via both by facsimile and e-mail, such would have been obvious to those skilled in the art when taken Ho alone. That is, the message could first be sent by e-mail and then latter by facsimile or at the same time. Furthermore, on line 2 in Ho's abstract, in col. 1 (lines 46-53), and in col. 2 (lines 19-22) Ho suggested transmitting in both facsimile and electron mail. Since his device could do both, doing both at different times or at the same time would have been obvious to those skilled in the art. Also, sending the message by facsimile and e-mail would have been obvious to those skilled in the art when taking Ho in view of Fabbio who taught of sending electronic mail and facsimile (e.g., see col. 3 (lines 4-23)) at the same time. "

The applicants respectfully traverse this contention of obviousness, and provide the following argument to show that these claims are nonobvious.

Applicants contend that it was not obvious to those skilled in the art at the time the invention was made to send a message both via facsimile and e-mail. It is the applicants' position that there is no motivation to modify Ho to send the message via both facsimile and email at the same time because such a combination would destroy the stated function of the Ho invention.

Ho teaches a communications device that transmits and receives information in accordance with both facsimile and electronic mail communications protocols. The communications device recognizes a destination identifier, identifying a remote communications device as **either** a facsimile device **or** an email device and transmits a document in accordance with the communications protocol utilized by the identified device. In order to transmit the document, Ho's invention requires that there be a direct connection from Ho's communication device 100 to the receiving

device. As shown in FIGs. 3 and 4, Ho does not transfer any document unless there is a successful direct connection (308, 310 and 318 of FIG. 3; 406, 408, 410 of FIG. 4). In fact, Ho indicates a failure if no such direct connection can be established (318 of FIG. 3, 408 of FIG. 4). Ho states, in column 7, lines 18-40,

"If at 304, the destination identifier is determined to be a telephone number, then at 306, the communications device dials the number. **If at 308 a successful connection cannot be established then at 309 the failure is indicated by generating and displaying at 318 an appropriate message on the display 208 and then returning at 311 to a mode where a new transmit or receive function may be initiated.** Upon establishment of a successful connection, the communications device proceeds to transmit at 310, the information on the document 101 in accordance with a facsimile communications protocol to the remote fax device...If at 304, the destination device is determined to be an e-mail address, then at 312, the communications device establishes a SLIP/PPP connection with Router 107. If a successful connection is obtained (block 314), then at 316, the information on document 101 is transmitted in accordance with the STP to a remote mailbox identified by the destination identifier. **If at 314 a successful connection cannot be established then failure is so indicated on display 208 at step 318 and the device returns to a state where it can accept a new transmit or receive command.**" (emphasis added)

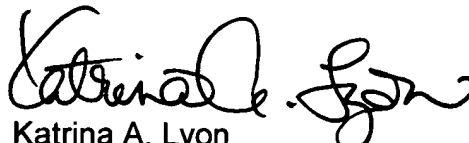
Hence, Ho's invention first determines what type of device it is sending to before it transmits a document and requires a successful connection with such a device before determining the format to send the data in and sending it. **Ho's invention would not work if it attempted to send both email and facsimile at the same time because it would not know which protocol to send the data with and could not send the data unless there was a direct connection. Ho's invention can only send email or facsimile messages at different times because it can only establish a direct connection with one device at a time.**

It is well settled in the law that a 35 USC 103 rejection based on a modification of prior art that destroys the function of the invention disclosed in the prior art, is improper and does not establish a prima facie case of obviousness. *In Re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no technological motivation for a worker to make such a detrimental modification. To the contrary, a significant disincentive exists. **In this case, the proposed formatting the message data for simultaneous**

transfer of a facsimile message and an email message would destroy the functionality of the Ho invention and so a prima facie case of obviousness cannot be established from the cited references.

In summary, it is believed that the foregoing arguments have placed the claims in condition for allowance. Therefore, reconsideration of the rejection of Claims 1-18 is respectfully requested. In addition, allowance of these claims at an early date is courteously solicited.

Respectfully submitted,

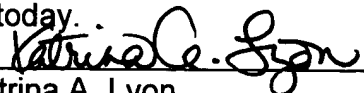


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CERTIFICATE OF MAILING

I hereby certify that the attached correspondence is being placed in First Class Mail addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 as of today.

 date: 8/7/01
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